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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/804,861	03/19/2004	Gail V. Atkin	59410US002	7643
32692	7590	10/25/2006	EXAMINER	
3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL, MN 55133-3427			BUI, LUAN KIM	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 10/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/804,861

Applicant(s)

ATKIN ET AL.

Examiner

Luan K. Bui

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 4-8, 10, 11, 13-16, 24 and 25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 9, 12, 17-23 and 26-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>7/26/04</u> . | 6) <input type="checkbox"/> Other: _____ |

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1. Claims 4-8, 10, 11, 13-16, 24 and 25 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 9/12/2006.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-3, 9, 12, 17, 18 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Dunn et al. (6,129,229; hereinafter Dunn'229). Dunn'229 discloses a tray (10) comprising a first section (11) having at least one receptacle for receiving a container (12), a second section (11) having at least one receptacle for receiving a container (12) and a coupling (60) movably connecting the first section to the second section to enable relative movement between the first section and the second section. The container of Dunn'229 is inherently capable to contain an orthodontic appliance.

As to claims 2-3, Dunn'229 discloses the coupling comprises a hinge having a pin for selectively disconnecting the first section from the second section (Figure 1).

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As to claims 18 and 19, Dunn'229 discloses each receptacle includes means (16, 28, Figures 6-8) for releasably retaining the container and since the container is contacting the means during insertion and removing from the receptacle which is considered equivalent to a friction fit.

4. Claims 26-28 and 32-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Corcoran et al. (2005/0178685; hereinafter Corcoran'685). Corcoran'685 discloses a tray (21) comprising a substrate (41) having two spaced-apart projections (45) and a receptacle (44) located between the projections. Each projection having an overhanging section that provides an undercut region adjacent the receptacle for releasably retaining a container (21b) that contains an orthodontic appliance (Figures 3A-6).

5. Claims 26-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Romick (5,489,025). Romick discloses a tray comprising a substrate (300) having two spaced-apart projections (306, 308) and a receptacle located between the projections. Each projection having an overhanging section (312) that provides an undercut region adjacent the receptacle for releasably retaining a container (200). The container of Romick is inherently capable to contain an orthodontic appliance.

6. Claims 1 and 17-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Dixon et al. (2001/0055741; hereinafter Dixon'741). Dixon'741 discloses in the embodiment of Figure 8, a tray comprising a first section (12c) having at least one receptacle (41c) for receiving a container (61c) that contains an orthodontic appliance (60c), a second section (12c) having at

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least one receptacle (41c) for receiving a container (61c) that contains an orthodontic appliance (60c) and a coupling (a connection between two sections, Figure 8A) movably connecting the first section to the second section to enable relative movement between the first section and the second section.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dunn' et al. (6,129,229; hereinafter Dunn'229). Dunn'229 discloses the tray as above having all the limitations of the claims except for the first section and the second section each includes fourteen receptacles in lieu of six receptacles. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the first section and the second section of Dunn'229 so each section comprises fourteen receptacles to allow the tray for holding more receptacles.

9. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dixon et al. (2001/0055741; hereinafter Dixon'741) in view of Jacobs et al. (5,636,736; hereinafter Jacobs'736). Dixon'741 discloses the tray in the embodiment of Figure 8 above having all the limitation of the claim except for the appliance comprises an adhesive. Jacobs'736 teaches an

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orthodontic appliance (13) comprising an adhesive (15, Figure 9). It would have been obvious to one having ordinary skill in the art Jacobs'736 to modify the appliance of Dixon'741 so it includes an adhesive in contact with the appliance to provide more convenient for the user.

10. Claims 29-31 and 33-36 are rejected under 35 U.S.C. 103(a) as being unpatentable Romick (5,489,025) in view of Dunn et al. (6,129,229; hereinafter Dunn'229). Romick discloses the tray as above having all the limitations of the claims except for the tray includes a first section, a second section and a coupling being movably connecting the first section to the second section. Dunn'229 shows a tray (10) comprising a first section (11) having at least one receptacle for receiving a container (12), a second section (11) having at least one receptacle for receiving a container (12) and a coupling (60) movably connecting the first section to the second section to enable relative movement between the first section and the second section. It would have been obvious to one having ordinary skill in the art in view of Dunn'229 to modify the tray of Romick so the tray comprises a first section, a second section and a coupling movably connecting the first section to the second section for better protecting the containers disposed within the tray during storage and/or transportation.

11. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 26 above, and further in view of Jacobs et al. (5,636,736; hereinafter Jacobs'736). Romick further fails to show an orthodontic appliance being received in the container. Jacobs'736 shows a tray (30) comprising a receptacle (36) for receiving a container (31) that contains an orthodontic appliance (Figure 12). It would have been obvious to one

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having ordinary skill in the art Jacobs'736 to modify the container of Romick as modified so the container includes an orthodontic appliance to allow the container for holding various articles.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luan K. Bui whose telephone number is 571-272-4552. The examiner can normally be reached on 8:30-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. **The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300 for Formal papers and After Final communications.**

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

lkb
October 24, 2006



Luan K. Bui
Primary Examiner
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